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**THIS DISPOSITION
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Paper No. 12
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jack Russo

Serial No. 75/527,748

Jack Russo of Russo & Hale LLP for Jack Russo.

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney).

Before Hanak, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Jack Russo has filed an application to register the
mark LAWYERSVIDEO for "providing legal information over a
global computer network."¹

Registration has been finally refused under Section
2(e)(1) on the ground that the mark is merely descriptive.
The Examining Attorney has also made final the requirement
that applicant submit advertisements or promotional

¹ Serial No. 75/527,748, filed July 30, 1998, based on an
allegation of a bona fide intention to use the mark in commerce.

materials. The refusal has been appealed and both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used or is intended to be used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

The Examining Attorney maintains that the proposed mark LAWYERSVIDEO is merely descriptive in that "videos about and for lawyers is a salient feature of applicant's legal information services." (Brief p.4). She has supported her refusal with excerpts from both the Internet and articles retrieved from the NEXIS database showing the use of videos both by various legal groups as a training means and by lawyers themselves in the litigation field.

Applicant agrees that his service is directed to lawyers but strongly disagrees that the mark as a whole is merely descriptive of a feature of applicant's information service. Applicant states that his service provides various types of information specifically related to helping lawyers involved in the litigation process, including information regarding the use of videos in depositions and trials, the use of graphics in litigation, the use of experts, etc., by means of the global computer network. He insists that his service "does not offer, sell or make videos for lawyers nor is Applicant's information service offered on videos." (Brief, p. 4). Applying a three-prong test, applicant argues that his mark is not merely descriptive under the "degree of imagination test" in that it takes mental pause or thought and imagination to discern the exact nature of applicant's services upon

viewing the mark LAWYERSVIDEO; that under the "competitors' need test" there is no need for others to use LAWYERSVIDEO to describe similar services; and that under the "competitors' use test" there is no evidence of record that others are actually using the term to describe similar services. Applicant further argues that the mark is not merely descriptive in that it does not tell potential customers only what the services are. Applicant contends that his services are not videos for lawyers and are not only information regarding the use of videos by lawyers.

As we have stated above, it is not necessary that a term describe all the characteristics or features of the involved services in order to be merely descriptive; description of one significant attribute will suffice. Here LAWYERSVIDEO clearly describes a significant feature of applicant's information service. As argued by the Examining Attorney, applicant's service relates to lawyers' videos, not in the sense that applicant is selling videos to lawyers, but rather in the sense that applicant is providing information to lawyers with respect to the use of videos during litigation. While the information provided may encompass many other areas of interest, nonetheless one area is that of the use of videos by lawyers in the litigation process. That the use of videos in this manner

would be of interest to lawyers and might well be an expected area covered by applicant's legal information service in the litigation field is demonstrated by the Internet webpage made of record by the Examining Attorney showing the advertisement that

[w]e fulfill all the Imaging, Video Production, Software Development, Electronic Data Discovery and Trial Consulting needs for Trial Lawyers.
(www.indatacorp.com)

The fact that this is one of the topics of applicant's service would result in an immediate correlation by prospective purchasers of applicant's service of the mark LAWYERSVIDEO and this particular facet of applicant's service. It would take no imagination or mental pause to grasp the connection between LAWYERSVIDEO and applicant's legal information service covering the area of the use of videos by lawyers. The mere juxtaposition of the two words LAWYERS and VIDEO into a single term does not in any way change the connotation of the words as such.

Furthermore, LAWYERSVIDEO is merely descriptive of applicant's information service in another sense. Although applicant states that he is not providing or selling videos to lawyers as such, the broad identification by applicant of his services as "providing legal information over a global computer network" does not rule out the possibility

that applicant would use videos in the implementation of his information service over the Internet. While the majority of the Internet pages and excerpted articles retrieved from the NEXIS database made of record by the Examining Attorney are directed to the offering of videos in the form of cassettes or closed circuit showings by organizations for purposes of legal training or education, nonetheless, we find certain excerpts which reference the direct use of videos on the Internet in the provision of informational or educational services. For example, we note the following:

Highlights Including Video

TrialDirector used in US v. Microsoft Antitrust Trial: Click here to see the video and read about how "(TrialDirector and) Technology changes the way evidence is presented in court." San Jose Mercury News

(www.indatacorp.com);

Click into cle-Net - - audio and video programs on the internet anytime.

(www.cle-net.edu);

Earn Audio/Video CLE credits on WSTLA'S Internet CLE via Taecan.com.

(www.wstla.org); and

Check Out Our "Streaming" Video

As part of our research and development efforts, we have put up a two-minute video clip featuring the editors of our book on Environment Law & Practice. Future efforts will appear on our Online Campus.

(www.pbi.org).

In this sense LAWYERSVIDEO is merely descriptive of a legal information program provided over the Internet which in fact makes use of videos in the presentation of the materials. As we stated above, applicant's service, as broadly identified, clearly encompasses such a use of videos, whether or not applicant presently intends to so use videos. Here also potential purchasers would readily make the association between LAWYERSVIDEO and applicant's information service for lawyers making use of videos in the presentation of the materials.

Applicant's arguments that competitors neither need nor use the term LAWYERSVIDEO to describe similar services are to no avail. As we have often stated, the fact that applicant may be the first and/or only user of the term for informational services of this nature is not controlling when the term unquestionably projects a merely descriptive connotation. See *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999).

Accordingly, we find LAWYERSVIDEO would be merely descriptive if used in connection with applicant's provision of legal information over a global computer network.

We next consider the Examining Attorney's requirement that applicant submit advertisements or promotional

materials, if available. The Examining Attorney has made this requirement final because applicant has failed to come forth with any materials of this nature.

Under Trademark Rule 2.61(b) an applicant may be required "to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application."

When first making the requirement for these materials, the Examining Attorney stated that "[i]f such materials are not available, the applicant must describe the nature, purpose and channels of trade for the services." In response, applicant did not provide any materials but instead gave a full explanation of the type of services with which he intended to use the mark.

We are fully convinced that applicant adequately complied with the Examining Attorney's requirement at this point in the prosecution. This is an intent-to-use application and advertising and promotional materials may not yet be available. The explanation given by applicant of the services with which he intended to use the mark was thorough and detailed. Although the Examining Attorney continued the requirement and applicant made no further reference thereto, we find that applicant had already satisfactorily met the requirement. We would note that

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applicant rightfully should have made a further response to the requirement by clearly explaining that either no materials were available, or, if available, why they were not provided, and that his detailed discussion of the services was intended to fulfill the requirement. Nonetheless, the refusal to register on the basis of failure to comply with this requirement is reversed.

Decision: The refusal to register under Section 2(e)(1) is affirmed. The requirement that advertising and promotional materials be submitted is reversed.

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